

REMARKS

By the present amendment, claims 1, 2, 8 and 12 have been amended to obviate the examiner's objections thereto and/or to further clarify the concepts of the present invention. Amended claim 1 now recites, among other things, that the electrolyte used for anodizing comprises an aqueous solution containing sodium aluminate, insoluble particles and sodium hydroxide, support for which may be found in original claim 9 and Example 1 of the subject specification. In addition, dependent claims 9 and 10 have been canceled. Entry of these amendments is respectfully requested.

In the Office Action, claim 2 was rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite. In particular, it was alleged that the phrase "ceramic oxide" was indefinite, because it did not refer to a specific type of particle. Reconsideration of this rejection in view of the above claim amendments and the following comments is requested.

By the amendments herein, claim 2 has been amended to delete the noted phrase. Accordingly, withdrawal of the rejection under the second paragraph of 35 U.S.C. § 112 is respectfully requested.

Claims 1-11 were rejected under 35 USC § 103(a) as being unpatentable over the patent to Hanagata et al in view of the patent to Hradcovsky. Reconsideration of this

rejection in view of the above claim amendments and the following comments is respectfully requested.

Before discussing the rejection in detail, a brief review of the presently claimed invention may be quite instructive. The subject invention relates to a method of making an oxide film where the method comprises immersing an object into an electrolyte, the object being made of magnesium or a magnesium alloy, and forming an oxide film on the object in the electrolyte by anodizing. It is a feature of the subject method that the electrolyte comprises an aqueous solution containing sodium aluminate, insoluble particles and sodium hydroxide, the oxide film taking in the insoluble particles as growing on the object. It is submitted that such a method is not taught or suggested by the cited patents to Hanagata et al and to Hradcovsky, whether taken singly or in combination.

More particularly, and as already noted in the Action, the Hanagata et al patent fails to teach or suggest an electrolyte that contains alkali metal hydroxide (or sodium hydroxide). While the patent may suggest an aqueous solution of an aluminate at column 2, lines 37-52, the patent does not specify that the aluminate is sodium aluminate. Further, it is to be noted that no aluminate is used in Examples 1-8, and that the only actual substrate material tested is aluminum, not magnesium.

It is submitted that these teaching deficiencies of the Hanagata et al patent are not supplied by the patent to Hradcovsky. As stated in the Action, the Hradcovsky patent allegedly discloses alkali metal hydroxide for addition to an anodizing electrolyte. However, it is submitted that this patent fails to specify that the alkali metal hydroxide is sodium hydroxide, and that sodium hydroxide should co-exist with sodium aluminate. Further, it should be noted that no aluminate is used in Examples 1-6 of the Hradcovsky patent, that the only alkali metal hydroxide used in these Examples is potassium hydroxide, and that the only actual substrate material tested is aluminum, not magnesium.

In the above respects, it is to be emphasized that the field of chemistry is the field of considerable uncertainty and thus everything must be proven by experiments. Consequently, unless all constituents of a specific composition are disclosed or suggested in a single document, such a composition should be considered to be new and unobvious. In other words, it is submitted that a combination of two or more documents in this field is basically illogical in alleging that a particular composition is obvious and therefore unpatentable.

For the reasons stated above, withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of claims 1 through 8 and 11 as amended over the cited patents are respectfully requested.

Claims 12 was rejected under 35 USC § 103(a) as being unpatentable over the patent to Hanagata et al in view of the patent to Hradcovsky further in view of the patent to Miyosawa et al. Reconsideration of this rejection in view of the above claim amendments and the following comments is respectfully requested.

The above remarks relative to the teaching deficiencies of the patents to Hanagata et al and Hradcovsky are reiterated with regard to this rejection. It is submitted that the patent to Miyosawa et al does not supply these teaching deficiencies. Since claim 12 is dependent on independent claim 1, it is submitted that this claim patentably distinguishes over the cited patents whether taken singly or in combination.

For the reasons stated above, withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of claim 12 over the cited patents are respectfully requested.

In view of the foregoing, it is submitted that the subject application is now in condition for allowance and early notice to that effect is earnestly solicited.

In the event this paper is not timely filed, the undersigned hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit

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Account No. 01-2340, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

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